

REMARKS

Claims 21 and 23-38 are pending. Claims 21, 23, 25-30, and 32-38 have been amended. No new matter is believed to be added by these amendments. In the Office Action dated November 5, 2007, claims 21, 23-35, and 38 were rejected as being unpatentable under 35 U.S.C. § 103(a) citing U.S. Pat. No. 6,931,657 (hereafter "*Marsh*") in view of U.S. Pat. No. 5,886,995 (hereafter "*Arsenault*") to support this rejection. Claims 36-37 were rejected as being unpatentable under 35 U.S.C. § 103(a) citing *Marsh* and *Arsenault* in view of U.S. Pat. No. 6,418,424 (hereafter "*Hoffberg*") to support this rejection. Claim 21 was objected to because of informality. Of these claims, only claims 21, 28, and 33 are independent claims. Claims 23-27, 29-32, and 34-38 respectively depend from these claims. Applicant respectfully requests allowance of all the pending claims in view of the subsequent remarks regarding the above-mentioned independent claims.

I. Claim Amendments

Applicant has amended the claims to clarify the invention. Particularly, Applicant has amended independent claims 21, 28, and 33 to clarify that "program information" is comprised of "a plurality of sets of available content streams for a plurality of program" and that each program has an associated set of available content streams. Furthermore, the user selects a subset from the set of available content streams associated with a program for recording. No new matter is believed to be added by these amendments. Support for these amendments can be found in the detailed description of the present application at least in paragraphs 65-74.

Claims 23, 26, 27, 30, 35, 36 and 38 have been amended for antecedent basis. These claims now refer to "available" content streams. No new matter is believed to be added by these amendments. Support for these amendments can be found in the detailed description of the

present application at least in paragraph 67.

Claims 25, 29, 34, and 38 have been amended to replace “includes” with “comprises.” Claim 32 has been amended to recite “available content streams” rather than “available content stream.” No new matter is believed to be added by these amendments. Support for these amendments can be found in the detailed description of the present application at least in paragraphs 65-74.

Claim 37 has been amended to clarify that information is sent “to” the modulator “from” the user device. No new matter is believed to be added by this amendment. Support for these amendments can be found in the detailed description of the present application at least in paragraph 79.

II. Claim Objections

Claim 21 was objected to because of informality on page 2 of the Office Action. Applicant respectfully traverses this objection to the extent that it is applied to claim 21 as amended. By amendment, Claim 21 no longer reads “a least.” This amendment removes the informality. Accordingly, Applicant requests reconsideration, withdrawal of this objection, and allowance of claims 21 and 23-38, as amended.

III. Claim Rejections Under 35 U.S.C. §103(a)

Claims 21 and 23-28 are currently pending in the present application. Of these pending claims, claims 21, 28, and 33 are independent claims. In the Office Action, claims 21, 28, and 33 were rejected under 35 U.S.C. §103(a) as unpatentable over *Marsh* in view of *Arsenault*.

Applicant first submits that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of

of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Marsh in view of *Arsenault* does not render claims 21, 28, or 33 obvious for at least the reason that all the claim limitations have not been met. *Marsh* does not teach the limitation of “provide a user option to select a desired subset of the set of available content streams associated with the particular program for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams” or “receive user input indicating the desired subset of available content streams for recording” as recited in claim 21 and similarly in claims 28 and 33, as amended.

Marsh is directed at a system for “selecting candidate television and multimedia programs for recording” by using an “intelligent content agent”. (See *Marsh*, Abstract). The intelligent content agent of *Marsh* is used to predict television shows that a user may be interested in. The intelligent agent can display a subset of programs/channels to a user for viewing. (See *Marsh*, Col 4, lines 60-67). The intelligent agent can also automatically record those programs/channels that may be of interest to a user. (See *Marsh*, Col. 5, lines 33-38). A user of the *Marsh* system can manage the recorded programs/channels and edit the programs/channels that will be recorded and delete programs/channels that have been previously recorded. (See *Marsh*, Col. 7, lines 20-24). The intelligent content agent uses this management information to make more informed decisions

information to make more informed decisions when selecting content for a user. (See *Marsh*, Col. 7, lines 25-31). To determine whether a program/channel would be of interest to a user, the intelligent content agent utilizes information found in electronic program guides. (See *Marsh*, Col. 5, lines 15-18). The intelligent content agent can filter programs/channels based on the content of the program/channel. The intelligent content agent can accomplish this by monitoring the closed caption text associated with a television show for certain keywords. If the closed caption text does not have certain keywords, the show is not recorded. (See *Marsh*, Col. 7, lines 40-53). If there is no closed caption text associated with a television show, the intelligent content agent can utilize an English voice recognition application to convert the audio portion of a television show into English text. If no English text is associated with the television show, then the intelligent content agent will delete the show. (See *Marsh*, Col. 7, lines 53-61).

The system of *Marsh* is much different than the presently claimed system. The present system is directed at permitting a user to select the “content streams” of a particular program or channel for recording. A program or channel is made up of various content streams. For example, if a user of the present system wanted to record a show with Ms. Julia Roberts, as in the *Marsh* system, the user of the present system would select whether they wanted to record the video content stream, the audio content stream, and/or the data content stream. There are many cases where there exist many audio content streams to choose from, for example, an English audio content stream and a Spanish audio content stream, all for the same television show. In the present system, a user can choose to only record the video content stream and the English audio content stream of the show with Ms. Roberts. This prevents unnecessary content stream recording and reduces the storage requirements.

As presently claimed, a user selects a subset of the available content streams associated with a particular program for recording. The *Marsh* system does not teach or suggest this limitation. The *Marsh* system, while providing an intelligent content agent to suggest television shows to a user, records all content streams associated with a program/channel. In the case of the television show with Ms. Roberts, the *Marsh* system would record the video content stream, the data content stream, the English audio content stream, a Spanish content stream, and possibly various sub-streams of the audio streams (an audio stream for 5.1 Surround audio, stereo audio, etc...). For the same television show, a user of the *Marsh* system would have a file stored on their digital recorder that takes up significantly more storage space than a user of the present system.

The Office Action, on pages 3-4, states that *Marsh* teaches the original limitation of “provide a user option to select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event.” The limitation now reads, “provide a user option to select a desired subset of the set of available content streams associated with the particular program for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams” as recited in claims 21 and similarly in claims 28 and 33, as amended. The Office Action refers to column 4, line 60 to column 6, line 8 and column 7, lines 40-61 of *Marsh* for this rejection. These portions of *Marsh* describe how the intelligent content agent can be utilized to identify a program that may be of interest to a user. However, as previously stated, there is no teaching in *Marsh* of allowing the user to select a subset of the various content streams that make up that program. In the present system, if a user is hearing impaired, the user of the present system can request that no audio content streams be recorded.

This user would only have the video and closed caption content streams stored, thereby reducing storage requirements by not recoding the audio content stream of the television show. In the *Marsh* system, no such choice is available to a user.

The Office Action, on page 4, states that *Marsh* teaches the original limitation of “receive user input indicating the desired subset of content streams from the program event for recording.” The limitation now reads, “receive user input indicating the desired subset of available content streams for recording,” as recited in claims 21 and similarly in 28 and 33, as amended. The Office Action refers to column 7, lines 20-39 of *Marsh* to support this rejection. Column 7, lines 20-39 of *Marsh* teaches a user managing the stored programs and viewer profile. This is merely deleting recorded or scheduled shows and editing the preferences of the user (for example, requesting shows with Ms. Roberts). The intelligent agent uses this management information to make more informed choices when automatically selecting shows for a user. This is much different than receiving a selection from a user as to whether the user wants the audio content stream of a television show recorded. The present system receives a selection from the user as to which content streams of a television show to record. For example, in the present system, the user can select just the audio and the data content streams, with no video being recorded. No such teaching is found in *Marsh*.

Arsenault does not correct these failings of *Marsh*. The Office Action, on page 4, states that *Arsenault* teaches the limitation of “the plurality of content streams including an audio stream for the program, a video stream for the program, and a data stream for the program” as recited in claim 21. This limitation is no longer found in claim 21 as amended. The Office Action refers to column 20, line 35 to column 21, line 40 of *Arsenault* to support this rejection. *Arsenault* merely teaches a stream of packets wherein the packets are video, audio, or data packets wherein

packets wherein information from a control packet is used to update generate a channel guide. Such a teaching does not overcome the failings of *Marsh* as stated above. Applicant earnestly requests reconsideration, withdrawal of this rejection, and allowance of claims 21 and 23-38, as amended.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int'l Co. v. Teleflex, Inc.* (KSR), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). In addition, the Court maintained that any analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is “important to identify reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR* at 14, 15.

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolocem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicant submits that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). As stated above, *Marsh* does not teach the limitations of “provide a user option to select a desired subset of the set of available content streams associated with the particular program for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams” or “receive user input indicating the desired subset of available content streams for recording” as recited in claim 21 and similarly in claims 28 and 33, as amended. *Arsenault* does not correct these failings of *Marsh*. *Arsenault* merely provides a stream of audio, video and data packets. It would not have been obvious to one of ordinary skill in the art to combine *Marsh*, *Arsenault*, and the subject matter of the limitations not taught by either, to arrive at the presently claimed invention. A motivation to combine *Marsh* and *Arsenault* merely creates *Marsh* plus a stream of audio, video and data packets, to conclude that such a combination provides the presently claimed invention requires hindsight reasoning. Applicant earnestly requests reconsideration, withdrawal of this rejection, and allowance of claims 21 and 23-38, as amended.

IV. Conclusion

Claims 21 and 23-38 are currently pending in the patent application. Of these pending claims, only claims claims 21, 28, and 33 are independent claims. Claims 23-27, 29-32, and 34-38 respectively depend from these claims. Since the Applicant respectfully asserts that the independent claims are allowable, dependent claims 23-27, 29-32, and 34-38 are also allowable.

Neither *Marsh* alone, nor in combination with *Arsenault* and/or *Hoffberg* renders obvious any of the pending claims, as the references fail to teach or suggest all the claim limitations and to combine *Marsh*, *Arsenault*, and the limitations of the claims not taught by either requires hindsight reasoning. Hence, claims 21 and 23-38, as amended, are in a condition for allowance.

In light of the remarks above, the Applicant respectfully requests that the Examiner send the application to issuance. If the Examiner believes that a telephone conference will facilitate an expeditious issuance of the current Application, he is invited to call the undersigned attorney.

No fees are believed due, however, the Commissioner is hereby authorized to apply any fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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